

REMARKS

In summary, claims 22-39 are pending. Claim 33 is objected to. Claims 22-39 are rejected under 35 U.S.C. § 103. Claims 31-33 and 37 are herein amended. No new matter is added. All claim rejections are traversed.

Telephone Conversation With Examiner

Examiner Au is thanked for the telephone conversation conducted on September 18, 2008. Cited art was discussed. Applicants' representative explained that he did not see several claim limitation in the cited art including: (1) determining whether (or not) to notify a user of an emergency alert broadcast based on user-defined preferences, (2) providing a periodic reminder of an emergency alert broadcast to the user, (3) providing the period reminder until an expiration date and time of the weather emergency, and (4) providing the period reminder until an indication to suspend a call in progress. Examiner Au said the he would have to look at the cited references more closely in view of Applicants' representative's explanations. No agreements were reached.

Drawings

Applicants note that no indication is provided, in block 10 on page 1 of the instant Office Action, that the drawings are acceptable. Applicants request that block 10 be checked indicating that the drawings are acceptable.

Claim Objections

Claim 33 is objected to because a period is missing at the end of the claim. Claim 33 is herein amended to include a period. Accordingly, it is requested that the objection to claim 33 be reconsidered and withdrawn.

Rejection Of Claims 22-30 Under 35 USC § 103

Claims 22-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 7,053,780, issued to Straub *et al.* (herein after referred to as “Straub”), in view of various combinations of US Patent No. 6,850,604, issued to Cannell *et al.* (hereinafter referred to as “Cannell”), US Patent No. 6,728,522, issued to Marrah *et al.* (hereinafter referred to as “Marrah”), US Patent No. 6,710,715, issued to Deeds (hereinafter referred to as “Deeds”).

Straub, Cannell, Marrah, and Deeds, whether considered individually or in any combination, neither disclosure nor suggest many claimed features. For example, Straub, Cannell, Marrah, and Deeds, whether considered individually or in any combination, neither disclosure nor suggest “determining whether to notify a user ... of the emergency alert broadcast based on user-defined emergency alert preferences” as recited in independent claim 22.

Straub is cited in the instant Office Action as teaching “determining whether to notify a user ... of the emergency alert broadcast based on user-defined emergency alert preferences.” (Emphasis added). Specifically, column 7, lines 28-67 of Straub are cited with a single supporting statement that “Straub discloses displaying search results based on points of interest.” (Page 3 of instant Office Action). It is not understood how displaying search results based on points of interest teaches “determining whether to notify a user ... of the emergency alert broadcast based on user-defined emergency alert preferences.”

Further, Applicants found no teaching in Straub in which a user is notified, or not notified, about the emergency alert broadcast based on user-defined preferences. In the cited passage (column 7, lines 28-67), Straub teaches that waypoints can be displayed to allow a user to, for example, “identify a suitable destination point when a weather alert is issued.” (Column 7, lines 45-46). According to the cited passage, the user always receives a notification of the emergency alert broadcast. There is no teaching of a user defined preference that would prevent the user from receiving a notification of the emergency alert broadcast.

Another example of claimed subject matter neither suggested nor disclosed by Straub, Cannell, Marrah, and Deeds, whether considered individually or in any combination, is

“providing a periodic reminder of an emergency alert broadcast ... the periodic reminder being continually provided until an expiration date and time of the weather emergency” as recited in claim 22.

In the instant Office Action, it is asserted that Straub teaches this claimed subject matter at column 8, line 1 through column 9, line 17; at column 7, lines 14-27; and in Figures 3A-3F. However, the Office Action provides no explanation as to how Straub is being interpreted to teach “providing a periodic reminder of an emergency alert broadcast ... the periodic reminder being continually provided until an expiration date and time of the weather emergency.” The cited passages and figures in Straub are directed to various ways to display waypoints and routes. It is not clear how this teaching is being construed to read upon “providing a periodic reminder of an emergency alert broadcast ... the periodic reminder being continually provided until an expiration date and time of the weather emergency.” In reviewing the cited passages and figures, it is noted that the word “periodic” appears in the cited passage only to describe that a voice signal can be periodically interrupted by an alert signal (see column 7, lines 20-22). However, there is no teaching of providing period reminders to a user, nor is there any teaching of continuously providing a periodic reminder until an expiration date and time of the weather emergency.

Combining Cannell, Marrah, and Deeds with Straub in any combination does not overcome the aforementioned deficiencies of Straub.

Further, Applicants agree with Examiner that Straub fails to disclose “providing a periodic reminder of an emergency alert broadcast ... the periodic reminder being continually provided ... until receipt of a first indication to suspend a wireless telephone call in progress” as recited in claim 22. Applicants disagree however, with the contention that Cannell cures this deficiency with Straub.

Applicants find no teaching of an emergency alert broadcast in Cannell. Cannell is directed to sending a data message to a calling phone while communicating with another phone.

It is not clear what, in Cannell, is being equated with an emergency alert broadcast because no explanation is provided as to how Cannell is being interpreted.

Moreover, the cited passage in Cannell teaches away from “providing a periodic reminder of an emergency alert broadcast ... the periodic reminder being continually provided ... until receipt of a first indication to suspend a wireless telephone call in progress.” Column 5, lines 11-21, of Cannell is cited to support the rejection of “until receipt of a first indication to suspend a wireless telephone call in progress.” However, column 5, lines 11-21 teach the opposite. Instead of teaching that an indication to suspend a wireless telephone call is received, column 5, lines 11-21 of Cannell teach that a current call is maintained. “[T]he called phone may hit ... [a] sequence of digits, which indicates to the communication system that the called phone wishes [*sic* wishes] to send a data message to the calling phone while maintaining and staying active in the current call.” (Emphasis added) (Column 5, lines 17-21). Thus, Cannell does not teach that an indication to suspend a wireless telephone call is received. Instead, Cannell teaches maintaining a call.

Moreover, it is respectfully submitted that a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because of a lack of rationale or explanation as to how Cannell is being asserted against the claims. The instant Office Action lacks enough information to assess how Cannell is being applied. Support is not provided for each claim limitation being rejected. No explanation is provided as to how Cannell is being interpreted to teach each claim limitation. In the instant Office Action, the reference to Cannell, to support the rejection of claim 22, comprise nothing more than a reference to passages in Cannell. Without providing rationale as to how a reference is being asserted against a claim, the burden to clearly articulate the rejection has not been met. “The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and other wise reply completely at the earliest opportunity.” (Emphasis added) M.P.E.P. § 706. “The pertinence of reference, if not apparent, must be clearly explained and each rejected claim specified.” (emphasis added) 37 § CFR 1.104 (c)(2), M.P.E.P. 706. [T]he

examiner bears the burden of proof to show patent invalidity. See *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985). Such proof must amount to a preponderance of the evidence to warrant rejection of claims. *Id.* Because the rejection of the claims has not been clearly explained in view of Cannell, this burden has not been met.

To support the rejection of claim 22 in view of Cannell, the instant Office Action recites only: “In an analogous art, Cannell teaches determining a call is in progress (col. 4 lines 20-29) and providing a period reminder of an incoming call to the user of the telecommunications device (col. 4 lines 61-65) and until receipt of a first indication to suspend a wireless telephone call in progress (col. 5 lines 11-21).” Because no clear articulation is provided explaining how Cannell is being interpreted to support the claim rejections, and because it is not obvious by reading Cannell how Cannell could be interpreted to support the claim rejections, a *prima facie* case of obviousness has not been established.

Additionally, a *prima facie* case of obviousness for rejecting claims 22-30 has not been established because it has not been explained why one of skill in the art at the time of the claimed subject matter would have been motivated to combine Straub and Cannell. And, it has not been explained how Straub and Cannell would be combined/modified to arrive at the claimed subject matter.

As required by law in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), the Office must show, *inter alia*:

- (1) the motivation (explicit or implicit) provided by the reference(s), common sense, or common knowledge that would have rendered the claimed invention obvious to one of ordinary skill in the art at the time of the invention;
- (2) a reasonable expectation of success;
- (3) the basis for concluding that the claimed invention would have been obvious to do or obvious to try when there are only a finite number of identified, predictable solutions; and
- (4) the reference(s) teach(es) the claimed invention as a whole.

Further, the MPEP provides several guidelines for rejecting a claim under 35 U.S.C. 103(a).

“Office personnel must explain why the differences(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. ... The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.” (Emphasis added)
MPEP § 2141. III

Additionally, the Examiner should explain how to combine the references, per MPEP 706.02(j).

“35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation >as to< why >the claimed invention would have been obvious to< one of ordinary skill in the art at the time the invention was made**.” (Emphasis added)

Moreover, when explaining how to modify a reference, “the proposed modification can not render the prior art unsatisfactory for its intended purpose” (MPEP 2143.01.V), and “the proposed modification can not change the principle of operation of a reference. (MPEP 2143.01.VI).

In direct contradiction with the holding of *KSR*, Examiner's support for establishing obviousness consists of a conclusory statement to desired results. Specifically, on page 4 of the instant Office Action, it is asserted that "[i]t would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Straub's system to include determining a call is in progress, providing a period reminder of an incoming call to the user of the telecommunications device and until receipt of a first indication to suspend a wireless telephone call in progress, as taught by Cannell, for the advantage of alerting the user of the phone of an incoming call when the user is engaged in a current call..." No articulated reasoning with some rational underpinning to support the legal conclusion of obviousness has been provided.

Examiner has not provided, as required, an explanation of the motivation for combining the references. That is, no explanation is provided as to why one of ordinary skill in the art at the time of Applicants' invention would have sought out, or why one of ordinary skill in the art at the time of Applicants' invention would have combined Straub and Cannell, once found. Further, Examiner has provided no explanation as how to combine Straub and Cannell.

The foregoing remarks and arguments also apply to claims 23-30, which depend upon claim 22.

Because: (1) Straub, Cannell, Marrah, and Deeds, whether considered individually or in any combination, neither disclosure nor suggest "determining whether to notify a user ... of the emergency alert broadcast based on user-defined emergency alert preferences," (2) Straub, Cannell, Marrah, and Deeds, whether considered individually or in any combination, neither disclosure nor suggest "providing a periodic reminder of an emergency alert broadcast ... the periodic reminder being continually provided until an expiration date and time of the weather emergency," (3) the burden to show, by a preponderance of the evidence, how Straub and Cannell are being interpreted to support the rejection of claims 22-30, and (4) a *prima facie* case of obviousness for rejecting claims 22-30 has not been established, it is requested that the rejection of claim 22-30 under 25 U.S.C. § 103 be reconsidered and withdrawn.

Rejection Of Claims 31-39 Under 35 USC § 103

Claims 31-39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Straub, in view of various combinations of Marrah and US Patent No. 7,233,781, issued to Hunter *et al.* (hereinafter referred to as “Hunter”).

Straub, Marrah, and Hunter, whether considered individually or in any combination, neither disclose nor suggest “determine whether to notify a user of the wireless telephone of an NOAA alert broadcast based on user-defined emergency alert preferences” as recited in amended independent claim 31, “provide a periodic reminder of an emergency alert broadcast containing information regarding a weather emergency to the user of the telecommunications device, the periodic reminder being continually provided until an expiration date and time of the weather emergency or until receipt of a first indication to suspend a wireless telephone call in progress” as recited in amended independent claim 31, or “determining whether to notify the user of the weather alert broadcast based on user-defined emergency alert preferences” as recited in amended independent claim 33.

The foregoing remarks and arguments with respect to the rejection of claims 22-30 also apply to the rejection of claims 31-39. Combining Hunter with Straub and Marrah, in any combination does not cure the aforementioned deficiencies of Straub and Marrah. Accordingly, it is requested that the rejection of claims 31-39 under 35 U.S.C. § 103 be reconsidered and withdrawn.

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PATENT

CONCLUSION

The Applicants believe that the present remarks are responsive to each of the points raised in the Office Action, and respectfully submit that all pending claims are in condition for allowance. Favorable consideration and passage to issue of the application at the Examiner's earliest convenience is earnestly solicited.

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